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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: John I. Ykema

Application No.: 09/213,099

Group No.: 2841

Filed: December 17, 1998

Examiner: T. Phan

For: POWER NODE CONTROL CENTER

Box Non-Fee
Assistant Commissioner for Patents
Washington, D.C. 20231

TRANSMITTAL LETTER

1. Transmitted herewith is response to restriction requirement for this application.
2. No additional fee for claims is required.

FEE DEFICIENCY

3. If any additional fee for claims is required, charge Account No. 50-1943.

Date: February 13, 2002



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(Amendment Transmittal--page 1 of 5)

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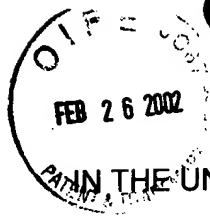
By: Darlene Dickinson

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Date: February 13, 2002

(Amendment Transmittal--page 2 of 5)

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ATTORNEY DOCKET: 76109.01001
PATENT

UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Patent application of
John I. Ykema

TO 2500 MAIL ROOM

Serial No.: 09/213,099

Group Art Unit: 2841

Filed: December 17, 1998

Examiner: T. Phan

For: POWER NODE CONTROL CENTER

#16/Election
R. Tyson
3/9/02

Commissioner of Patents and Trademarks
Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT

**I. TRAVERSE, REQUEST FOR RECONSIDERATION
AND PROVISIONAL ELECTION**

This is submitted in response to an office action having no paper designation number but dated 14 January 2002 wherein the examiner required restriction of the subject matter disclosed in the above-referenced patent application. Applicant, through his undersigned attorney, hereby traverses the restriction requirement in all of its respects, requests reconsideration and withdrawal of the requirement for restriction and further requests a prompt and thorough examination of all of the claims pending in the application, on their merits.

Initially, applicant respectfully notes that the restriction requirement made by the examiner does not account for claim 34 pending in the application. In light of this, applicant believes a new or supplemental official action addressing the

status of claim 34 and re-setting the date for response to the paper dated 14 January 2002 is appropriate and so is requested.

Applicant further notes that in levying the restriction requirement, the examiner has placed claim 26 in group I as allegedly being drawn to an electrical control module power node but has placed claims 27-33, all of which depend directly or indirectly from claim 26, in group III as being drawn to a power bus back plane. Applicant respectfully submits that the language of claim 26 on its face indicates this to be an error in assigning claim 26 to group I. Reconsideration of claim 26 in this regard is respectfully solicited. Applicant believes this is another reason justifying issuance of a new of supplemental official action, re-setting the date for response.

Without prejudice to the foregoing traverse and request for reconsideration and without prejudice to Applicant's right to petition against the restriction requirement, in compliance with the requirement set forth in the official action Applicant provisionally elects the claims of Group I, namely claims 1-26, 35 and 52-74, which the Examiner has characterized as being directed to electrical control module power nodes.

II. ARGUMENT

A. Practical And Equitable Considerations Mandate Review Of Applicant's Claims As A Single Application

A close examination of the practical and equitable considerations surrounding the present case compels withdrawal of the examiner's restriction

requirement and requires examination of all the claims presented in a single patent application.

1. Scope Of Search

The salient consideration for insisting upon restriction and determining the propriety of a restriction requirement is the scope of the examiner's search for prior art. Applicant is entitled to a full and thorough search of the prior art as a consequence of having filed his application and having paid the statutory application fee. 35 U.S.C. 131.

Restriction is proper only where the examiner would be unduly burdened by searching numerous, unrelated inventions or technologies. Thus, the scope of a search for related inventions, even though burdensome, cannot justify restriction of the related inventions. Further, even if an application includes claims to unrelated inventions, i.e., distinct and independent, the examiner **must** examine the application on its merits, in its entirety, if the search and examination of the entire patent application can be made without a serious burden on the examiner. M.P.E.P. 803.

The examiner's instructional guidelines for performing a search for any application are set forth in the M.P.E.P. The guidelines compel the examiner to search in classes and subclasses in which independent and distinct (as defined by the M.P.E.P.) inventions would be classified. For example, section 904.01(c) recites:

"Not only must the art be searched with which the invention claimed is classifiable, but also all analogous arts **regardless of where classified**. The determination of when arts are analogous is at times difficult. It depends upon the necessary essential function or

utility of the subject matter covered by the claims, and not upon what it is called. (emphasis added).

Section 904.01(d) recites:

A proper field of search includes the subclass in which the claimed subject matter of an application would be properly classified.

In outlining a field of search the examiner should note every class and subclass under the U.S. Patent Classification system and other organized systems of literature, **that may have material pertinent to the subject matter as claimed.** Every subclass, digest and cross reference art collection pertinent to each type of invention claimed should be listed, from the largest combination through the various subcombinations to the most elementary part. **The search should extend to all probable areas relevant** to the claimed subject matter and should cover the disclosed features which might reasonably be expected to be claimed.

The examiner should plan a search that not only covers the claimed subject matter, but one that also covers the disclosed features that might reasonably be expected to be claimed. (emphasis added).

Section 904.02 recites:

It is a prerequisite to a speedy and just determination of the issues involved in the examination of an application that a careful and comprehensive search, commensurate with the limitations appearing in the most detailed claims in the case, be made in preparing the first action on the merits so that the second action on the merits can be made final or the application allowed with no further searching other than to update the original search. It is normally not enough that references be selected to meet only the terms of the claims alone, especially if only broad claims are presented; **but the search should, insofar as possible, also cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant's amendment.**

It thus results that the examiner finds references that, while not needed for treating the claims, would be useful for forestalling the possible presentation of claims to other subject matter regarded by applicant as his or her invention, and claimable with the subject matter being currently claimed, but shown to be old by these references. (emphasis added).

From the above-quoted guidelines, it is clear that the scope of a proper search includes:

- (1) Classes and subclasses in which the claimed subject matter is classified;
- (2) Classes and subclasses that may have material pertinent to the claimed subject matter; and
- (3) Classes and subclasses containing subject matter present in the disclosure which might reasonably be expected to be claimed during the prosecution; and,
- (4) Classes and subclasses that may contain subject matter disclose material related to features which might reasonably be expected to be claimed.

Therefore, only where inventions are independent and distinct (as defined by the M.P.E.P.) and require nonoverlapping searches, is restriction proper.

The various disclosed and claimed structures are interrelated, work together and merit patent protection. They are all directed to a common technology, and stem from a set of core inventive concepts. Thus, the examiner will not be unduly burdened by searching and examining all of the claims presented by Applicant in a single application. The examiner's search will not be narrowed or reduced by compliance with the restriction requirement, since Applicant has clearly manifested his intent to claim each novel and nonobvious aspect of the disclosed subject matter as evidenced by the claims in the application.

The searches performed by the examiner will be identical regardless of which group of claims the examiner initially searches. As such, it would be a total waste of time, money and energy to require the examiner to perform the

same search four times. This alone should be sufficient for the examiner to reconsider and withdraw the restriction requirement and to proceed with a meritorious examination of all of the claims pending in the application.

**2. Cost To Applicant of the Proposed
Restriction Would Be Unduly Burdensome**

While the Patent and Trademark has a legitimate interest in obtaining proper revenue from filing and issuance fees, it does not have unrestrained power to tax inventors or entrepreneurial enterprises. Applicant is entitled to obtain patent protection on each of the nonobvious inventive aspects of the subject matter which applicant has disclosed. If the Applicant is forced to divide this application into four separate patent applications as suggested by the examiner, this will be unduly and unfairly burdensome due to the excessive fees and costs associated with prosecuting and maintaining three additional patents.

**3. The Patent Office's First Responsibility Is
Public Service, Not Collecting Revenue**

While Applicant recognizes the Patent & Trademark Office's interest in obtaining proper revenue from filing and issuance fees, the Patent & Trademark Office is not in the business of assisting the IRS in reducing the national debt. The sole function of the Patent & Trademark Office is to serve the public in an efficient and expeditious manner. The Patent & Trademark Office is charged with a duty to carry out its responsibility of examining patent applications in a manner most efficient to the public. Efficient use of administrative resources and expeditious processing of this application will be better served by performing one


comprehensive search as contrasted to four largely, if not completely, overlapping searches.

IV. CONCLUSION

For all of the foregoing reasons, applicant respectfully submits that the restriction requirement currently in the application is not well-founded and should be withdrawn, with all of the claims pending in the application being examined collectively following a single, comprehensive search of the prior art. Notification that the restriction requirement has been reconsidered and withdrawn is respectfully solicited.

Respectfully submitted,

Date: February 13, 2002

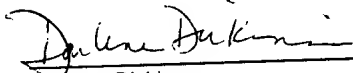


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Darlene Dickinson
February 13, 2002